

**REMARKS**

This is a response to the Office Action dated September 22, 2005.

**I. SUMMARY OF OFFICE ACTION**

In the Office Action, the Examiner indicated that the prior art items submitted on the information disclosure statement mailed December 23, 2003 by the Applicant that do not have a date are not considered to be prior art. As such these items have not been considered by the Examiner.

Claims 39-67 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention based on a contention that Claim 39 states that both the first end and the second end of the outer lifting structure are connected to the upper support cradle. Furthermore, the Examiner noted that Claims 40-44 depend from a cancelled claim, and thus, these claims are indeterminate of scope and have not been further treated on the merits.

Claims 39, 55, 59 and 60 were rejected under 35 U.S.C. §102(b) as being anticipated by Wolk. Claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wolk in view of Chiesa et al. Claims 39, 46-49, 55, 59 and 60 were rejected under 35 U.S.C. §103(a) as being unpatentable over Motorcyclejacks.com in view of Wolk. Claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over Motorcyclejacks.com in view of Wolks *supra* and further in view of Chiesa et al.

**II. APPLICANT'S RESPONSE**

**A. PRIOR ART**

In the Office Action, the Examiner referred to the Wolk reference. However, the Wolk reference was not been listed on the Notice Of References Cited. On about December 6, 2005, James C. Yang, an associate with the firm of Stetina Brunda Garred & Brucker, contacted the Examiner to obtain the patent number of the Wolk reference. The Examiner associated U.S. Pat. No. 3,991,857 with the Wolk reference.

Applicant respectfully requests the Examiner to list the Wolk reference on the Notice Of References Cited in the next Office Action.

**B. CLAIM REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

In the Office Action, Claim 39 was rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action states that Claim 39 recites that both the first end and the second end of the outer lifting structure are connected to the upper support cradle. By this amendment, Applicant amends Claim 39 by replacing the term “outer” with the term “inner”, as shown above. Applicant respectfully submits that such amendment to Claim 39 overcomes the Examiner’s rejection of Claim 39 under 35 U.S.C. §112, second paragraph.

Claims 40-44 were also rejected under 35 U.S.C. §112, second paragraph based on a contention that such claims depend from a cancelled claim. By this amendment, Applicant has amended Claim 40 to depend on Claim 39. Accordingly, the Examiner’s rejection of Claim 40-44 under 35 U.S.C. §112, second paragraph have been overcome. Also, Applicant requests examination of these claims on the merits.

**C. CLAIM REJECTIONS UNDER 35 U.S.C. §102(b)**

**i. Claims 39-52 and 58-67**

In the Office Action, Claim 39 was rejected under 35 U.S.C. §102(b) as being anticipated by Wolk. In response, Applicant has amended Claim 39 to further recite that the upper cradle support is an upper wheel cradle support wherein the wheel cradle support is sized and configured to receive tires of a motorcycle. Applicant respectfully submits that Wolk does not disclose, suggest or make obvious such limitation. In support thereof, as discussed in the Abstract, Wolk is directed to a material handling device. The Wolk device is not directed to a motorcycle lifting device. Accordingly, the Wolk reference does not disclose the wheel cradle support recited in Claim 39.

Moreover, there is no motivation to modify the Wolk reference such that the support is a wheel cradle support based on a contention that the Wolk device is a general materials handling device. If the cradle support of the Wolk device was modified so as to be a wheel cradle support, then the Wolk device would no longer be a general materials handling device and would not be capable of raising and lowering materials of a broad spectrum. It would only be limited to raising and lowering wheeled items. As such, if the Wolk device was modified, then the Wolk device would be made inoperable for one of its intended purpose, namely carrying a broad

spectrum of variously configured items. MPEP § 2143 (V) recites that “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Thus, the Wolk reference does not disclose, suggest or make obvious the invention recited in Claim 39.

Claim 39 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Motorcyclejacks.com in view of Wolk. The Examiner stated that “Motorcyclejacks.com shows a motorcycle lift having a lift structure attached to a wheel support cradle.” (See Page 3 of the Office Action). Applicant has reviewed the Motorcyclejacks.com reference and was unable to find a wheel cradle support. As understood, the lift of Motorcyclejacks.com does not contact the wheel to raise the motorcycle. Rather, the lift is slid under the engine of the motorcycle at the side of the motorcycle and lifted up via a foot operated pump. The motorcyclejacks.com device does not appear to even remotely engage the wheel. As such, the Motorcyclejacks.com reference does not disclose, suggest or make obvious the invention recited in Claim 39.

For the foregoing reasons, Applicant respectfully submits that the invention recited in Claim 39 is in condition for allowance.

The dependent claims of Claims 39, namely, Claims 40-52 and 58-67 are also in condition for allowance for containing additional patentable subject matter. For example, Claim 41 recites a roller wheel assembly mounted to a first cross member of the first rearward end of the outer lifting structure. The roller wheel assembly permits the user to move the lifting device around similar to that of a dolly, as explained in paragraph 84, and also permits the outer lifting structure to roll on the ground as the upper cradle support is traversed between a non-deployed position and a fully-deployed position, as explained in paragraph 62. Hence, with one of the set of rollers, two functions are performed.

The cited prior art does not disclose a roller wheel assembly attached to the lifting device which performs both functions. The device of Motorcyclejacks.com appears to have a first roller wheel assembly near the foot pedal. However, the first roller wheel assembly is not rolled on the ground as the upper cradle support is traversed between the non-deployed position and the fully deployed position. A second roller assembly is used for that purpose. Note that omission of an element and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966). MPEP 2144.04 (II)(B). Since the invention recited in Claim 41

omits an element (i.e., either first or second roller assembly) but retains both functions, the invention recited in Claim 41 is unobvious over the cited prior art.

For these reasons, Applicant respectfully submits that Claim 41 is in condition for allowance for containing additional patentable subject matter. Also, the remaining dependent claims of Claim 39, namely Claim 40-52 and 58-67 are believed to be in condition for allowance for containing additional patentable subject matter. The remaining dependent claims of Claim 39 are also believed to be in condition for allowance for being dependent upon an allowable base claim.

ii. Claims 53-57

In the Office Action, Claim 53 was rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention based on a contention that its base Claim 39 recites an impossible circumstance, namely that both the first end and the second end of the outer lifting structure are connected to the upper support cradle. As discussed above, such inconsistency with respect to Claim 39 was corrected, and thus the Examiner's rejection of Claim 53 under 35 U.S.C. §112, second paragraph has been overcome. Claim 53 has further been amended to incorporate the limitations of its base independent Claim 39, and thus, Claim 53 is now an independent claim. Accordingly, Claim 53 is now in condition for allowance.

The dependent claims of Claim 53 are also believed to be in condition for allowance for containing additional patentable subject matter and for being dependent upon an allowable base claim. By way of example and not limitation, in the Office Action, the Examiner did not reject Claims 54, 56 and 57 which depend on Claim 53 under sections 102 or 103. The Examiner did reject these claims under 35 USC § 112, second paragraph. However, as discussed above, such rejection has been overcome. As such, Claims 54, 56 and 57 are believed to be in condition for allowance for containing additional patentable subject matter as well as Claim 55. Claims 54-57 are also believed to be in condition for allowance for being dependent upon an allowable base claim.

iii. Claim 68

Applicant respectfully requests entry of new Claim 68 into the prosecution of the above-identified patent application. New Claim 68 is a broader version of amended Claim 53. Claim 68 is believed to be novel and non-obvious in view of the cited prior art based on a contention

that the cited prior art does not disclose, suggest or make obvious the limitation of the jack drawing the second rearward end closer to the first forward end to raise said upper cradle support from a non-deployed position to a fully deployed position. The Motorcyclejacks.com reference is not a scissor lift. Also, the Chiesa reference is not a scissor lift. The Wolk reference is a scissor lift. However, the second rearward end is not brought closer to the first forward end to raise the upper cradle support from a non-deployed position to a fully deployed position. Rather, the rearward ends of the first and second lifting structures are spread apart to raise the upper cradle support. Accordingly, Applicant respectfully submits that the cited prior art does not disclose, suggest or make obvious the invention recited in Claim 68.

iv. Claim 69

Applicant also respectfully requests entry of new Claim 69 into the prosecution of the above-identified patent application. New Claim 69 is believed to be in condition for allowance based on the contention that the cited prior art does not disclose, suggest or make obvious a roller wheel assembly rotatably attached to the second rearward end of the second lifting structure for rolling the second rearward end of the second lifting structure toward the first forward end of the first lifting structure when raising the upper cradle support to the fully deployed position and moving the lifting device similar to that of a dolly when the cradle support is in the non-deployed position. Claim 69 recites similar subject matter to that of Claim 41 discussed above. For the same reasons that Claim 41 is believed to be in condition for allowance, Applicant respectfully submits that new Claim 69 is also believed to be in condition for allowance.

**D. PRIOR ART**

Applicant acknowledges receipt of the prior art made of record and not relied upon, but considered by the Examiner to be pertinent to Applicant's disclosure. Applicant respectfully submits that the cited prior art, either alone or in combination does not anticipate, suggest, or make obvious the instantly claimed invention.

**III. CONCLUSION**

For the foregoing reasons, Applicant respectfully submits that all the stated grounds of rejection have been overcome, and that Claims 39-69 are in condition for allowance. An early notice of allowance is therefore respectfully requested.

Application No.: 10/674,221  
Attorney Docket: THURM-005A

Should the Examiner have any suggestions for expediting allowance of the application, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

If any additional fee is required, please charge deposit account number 19-4330.

Respectfully submitted,

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